

REMARKS

In the Office Action, the Office rejected pending claims 75, 78-83, 85, 87 and 114. More particularly:

- The Office rejected claims 79 and 87 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement;
- The Office rejected claims 78, 79, 87 and 114 under 35 U.S.C. §112, second paragraph, as failing to point out and distinctly claim the subject matter regarded as the invention;
- The Office rejected claim 75 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,953,710 to Fleming (“Fleming”);
- The Office rejected claim 75 under 35 U.S.C. §103(a) as being unpatentable over “Bank on Youth: More Children Are Learning to Save Money, With Financial Institutions Helping Offering No-Fee Accounts,” Barbara Bronson Gray, Los Angeles Times, Feb. 12, 1993, pg. 25 (“Gray”) in view of Official Notice;
- The Office rejected claims 78-83, 85, 87 and 114 under 35 U.S.C. §103(a) as being unpatentable over either Fleming or Gray and Official Notice in view of U.S. Patent No. 5,500,513 to Langhans et al. (“Langhans”); and
- The Office rejected claims 75, 78-83, 85, 87 and 114 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 7,653,595.

Claims 75, 78 and 87 have been amended. No new matter has been added as a result of these amendments. Upon entry of this Amendment and Response, claims 75, 78-83, 85, 87 and 114 remain pending. For the reasons set forth below, Applicant requests that the rejections associated with the pending claims be withdrawn.

Rejections Under 35 U.S.C. §112, first paragraph

The Office rejected claims 79 and 87 under 35 U.S.C. §112, first paragraph, for including subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art the invention at the time the application was filed. With respect to claim 87, the Office asserts that the limitation “prohibiting...spending on alcohol or tobacco” functionally defines the boundaries of a genus, and that the specification fails to disclose an algorithm for achieving the desired result of prohibiting the sale of alcohol or tobacco. While Applicant respectfully disagrees, Applicant has amended claim 87 to expedite prosecution. In light of the amendments, the rejection of claim 87 under 35 U.S.C. §112, first paragraph is moot.

The Office rejected claim 79 for similar reasons. However, claim 79 finds support in the present specification as filed at at least page 21, lines 16-26.

Accordingly, Applicant respectfully requests that the §112, first paragraph, rejections associated with claims 79 and 87 be withdrawn.

Rejections Under 35 U.S.C. §112, second paragraph

The Office rejected claims 78, 79, 87 and 114 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention.

With respect to claim 78, the Office asserts that it is unclear how a third party account can initiate a cash withdrawal or fund transfer, and that it is unclear how the method can limit the spending of cash. Claim 78 has been amended to clarify its limitations. As such, Applicant respectfully requests that the §112, second paragraph, rejection associated with claim 78 be withdrawn.

The Office fails to explain why it considers claims 79, 87 and 114 to be indefinite under 35 U.S.C. §112, second paragraph. Applicant does not believe that these claims are indefinite, and without an explanation as to the rationale behind the rejection, Applicant is unable to further respond to these rejections.

Accordingly, Applicant requests that the §112, second paragraph, rejections associated with claims 78, 79, 87 and 114 be withdrawn.

Double Patenting Rejections

The Office rejected claims 75, 78-83, 85, 87 and 114 on the grounds of non-statutory obviousness-type double patenting over claims 1-10 of U.S. Patent No. 7,653,595, and noted that this rejection could be overcome with the filing of an appropriate terminal disclaimer. Accordingly, a terminal disclaimer is filed herewith to overcome this rejection. As such, Applicant respectfully requests that the double patenting rejections associated with claims 75, 78-83, 85, 87 and 114 be withdrawn.

Rejections Under 35 U.S.C. §102(e)

The Office rejected claim 75 under 35 U.S.C. §102(e) as being anticipated by Fleming. Applicant submits that this rejection is improper for at least two reasons: (a) Fleming is not prior

art; and (b) even if Fleming is prior art, which Applicant explicitly denies, Fleming is not enabling and therefore cannot be an anticipatory reference under §102.

Fleming is Not Prior Art

The Examiner acknowledged but did not grant Applicant's claim for benefit of prior-filed U.S. Patent Application Serial No. 08/585,173 (the "173 Application") filed April 16, 1996. The Examiner stated that the '173 Application "fails to provide the necessary support for such limitations as 'computer-based,' 'establishing computer transfers of allowance money,' and 'said transfers to occur periodically and automatically under computer processor control'" of claim 75. Applicant respectfully disagrees.

Applicant contends that the '173 Application provides sufficient information and direction to have allowed one of ordinary skill in the art at the time of the invention to have understood that a computer-based implementation of the inventive allowance card and support system as presently claimed was intended.

The '173 Application discloses the implementation of the allowance card invention disclosed therein through a credit card network in which money is transferred to a child every month and the parent receives information on how the money is spent. In particular, the '173 Application states:

The philosophy of the Allowance Card and how it works is very simple. A major credit card company [such as] Visa, MasterCard, Discovery [(sic.)]. AmEx, will be the support. Say John Doe has a card such as those stated above. He has a son and a daughter in high school and wants to give them a monthly allowance but is afraid just handing out money and where they are spending it. He has the card company issue two allowance cards under his main account. He tells the card company to take \$80 dollars a month, charge it to his account, and put \$40 to each of his children's allowance cards. They can only spend that \$40, no more [. I]f they choose to spend it quicker or slower within the month it is their choice[. T]he parent is disciplined not to give them anymore money until the next month and the kids are disciplined by the Allowance Card constraints.

The disclosure also states that the allowance card allows quick and direct money transfers and documents the day, place, amount and items that were purchased. While the presently claimed invention may have started out as an idea conceived by the inventor to issue spending cards to children on which a periodic allowance could be loaded, by the time the '173 Application was filed, the inventor had come to realize that the computer network of a credit

card company could be used to make the periodic and automatic transfer of money to “siblings, children and others who are dependent on wage earners...college students, handicapped people...[emphasis omitted].”

This demonstrates that at least as of the April 16, 1996 filing date of the ‘173 Application, the inventor was in possession of transferring allowance money periodically and automatically under computer processor control, to which claim 75 is directed.

This is further evidenced by the Declaration of Dr. David Lucantoni, which the Office has considered but, without explanation, deems unpersuasive. The Declaration elaborates in additional detail how the computer-based context in which Applicant’s invention would have been understood to have operated. In particular, as noted in the Declaration, then-existing credit card and banking computer networks were capable of implementing the allowance card and its system, hereinafter collectively referred to as “the allowance card system,” as defined by the presently amended claims.

According to Dr. Lucantoni, a person of ordinary knowledge and skill in matters involving credit and debit cards, upon being informed of the allowance card concept related by the ‘173 Application, and informed by the ‘173 Application that it would be supported by a major credit card company, would have understood this to encompass transferring allowance money periodically and automatically under computer processor control, to which Claim 75 is directed. To the extent this is not expressly described, it would be inherently or implicitly conveyed to them. Furthermore, existing credit card and banking networks were capable at that time of implementing the invention as it is now claimed.

As noted by Dr. Lucantoni, there are several features of the allowance card system for which a computer network is required for any reasonably practical application. For example, linking the allowance card to a third-party account for quick and direct money transfers and documenting the day, place, amount and items that were purchased, as well as enforcing transaction limits – where information from more than one merchant might be needed in a short time span – are simply not practical unless a computer system and database are used.

For these reasons, as well as those previously presented in the Office Action dated June 29, 2011, Applicant contends that the present application is entitled to receive the benefit of the filing date of the ‘173 Application. Because Fleming was filed October 9, 1996, whereas the

present application claims priority from the '173 Application which was filed April 16, 1996, Fleming is not prior art against the present application, and Applicant respectfully requests that the rejection of claim 75 under 35 U.S.C. §102(e) be withdrawn.

Fleming Is Not Enabling and Therefore Not Anticipatory

Even if Fleming is prior art, which Applicant expressly denies, Fleming cannot be used as an anticipating reference under 35 U.S.C. §102(e) because, applying to the Office's rationale, Fleming does not enable a person of ordinary skill in the art to carry out the invention.

In order to be anticipating, a prior art reference must be enabling so that the claimed subject matter may be made or used by one skilled in the art. *Impax Labs., Inc. v. Aventis Pharms. Inc.*, 545 F.3d 1312, 1314 (Fed. Cir. 2008). Said another way, prior art is not enabling so as to be anticipating if it does not enable a person of ordinary skill in the art to carry out the invention. *Id.*

As described above, the Office refuses to afford the present application the benefit of the priority date of the '173 Application because the Office asserts that the '173 Application does not provide sufficient enablement of a computer-based implementation. Despite Dr. Lucantoni's Declaration which details how the computer-based context in which Applicant's invention would have been understood to have operated, the Office continues to maintain this assertion. However, based on the Office's rationale, Fleming also fails to provide sufficient enablement of a computer-based implementation.

Fleming provides that the bank systems described by the Fleming system "use conventional computer and telecommunications equipment." Fleming at 5:30-32. Dr. Lucantoni's Declaration makes clear that one of ordinary skill in the art would have understood the '173 Application to utilize such conventional bank computers and telecommunication equipment. However, the Office refuses to acknowledge that the '173 Application provides sufficient enablement. According to the Office's own rationale, Fleming cannot be an anticipatory reference because it too, by its own disclosure, simply utilizes conventional bank systems and equipment.

For at least these reasons, claim 75 is not anticipated by Fleming. Because claims 78-83, 85, 87 and 114 depend from and incorporate all of the limitations of claim 75, claims 78-83, 85,

87 and 114 are also patentable over Fleming. As such, Applicant respectfully requests that the §102(e) rejections associated with claims 75, 78-83, 85, 87 and 114 be withdrawn.

Rejections Under 35 U.S.C. §103(a)

Claim 75

Amended independent claim 75 is non-obvious over Gray in view of Official Notice because Gray and Official Notice, whether considered alone or in combination, do not teach or suggest each and every limitation of independent claim 75. More particularly, the combination of Gray and Official Notice fails to teach or suggest at least the following limitations of claim 75:

- creating a third party account using information received from a fund depositor;
- preventing or allowing debit card access to said third party account using information received from said fund depositor; and
- supplying to said fund depositor information on payees and corresponding payment amounts for said third party account.

Gray is an article that describes programs through certain banks that provide students with a personalized kit including an automatic teller machine card and personalized deposit and withdrawal forms for their own no-fee savings accounts. Gray at pg. 1. The accounts allow automatic deposit so that a parent can deposit cash into the student's account on occasion if desired. *Id.* However, as acknowledged by the Office on page 8 of the Office Action, Gray fails to teach or suggest that an account is created using information received from a fund depositor and that the information on payees and payment amounts is supplied to that fund depositor. However, the Office invokes Official Notice to resolve the deficiencies of Gray, namely that parents will set up accounts for children and read their mail. Applicant, respectfully disagrees with the Office's assertion of Official Notice.

Official Notice is permissible only for certain types of facts; those that are capable of instant and unquestionable demonstration as being well-known. §MPEP 2144.03. The basis for Official Notice must be set forth explicitly, and the Office must provide specific factual findings predicated on sound technical and scientific reasoning to support a conclusion of common knowledge. *Id.*

Furthermore, Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. *Id.* Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art[,], are capable of instant and unquestionable demonstration as being well-known. *Id.* It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. *Id.* (Emphasis in original.)

Here, the Office asserts on page 8 of the Office Action that “it is old and well known in the art that parents do things for their children and read their correspondence because a parent often has incentives for doing so and it is often societally acceptable for a parent to do so.” However, this is contrary to the teaching in Gray in which the bank in question, Wells Fargo, contemplates the allowance recipient being responsible for reviewing the statement, checking the interest, etc. (*See* Paragraph 5 of Gray.)

In other words, Official Notice has been taken by the Office to contradict and manipulate the teachings of Gray in order to support the use of Gray to reject the claims. This is akin to taking Official Notice to change a teaching of “North” into a teaching of “South” when an applicant asserts the “South” feature to be novel and non-obvious. Furthermore, while it may be common knowledge that parents “do things for their children,” this rationale fails to explain why creating an account using information received from a fund depositor would be common knowledge at the time of the invention. Moreover, while the present application describes a parent/child relationship, claim 75 is not limited to such an arrangement. Rather claim 75 requires creating a third party account using information received from a fund depositor. In the absence of documentary evidence demonstrating Wells Fargo’s practice to be the exception rather than the rule, the Official Notice taken to change the teachings of Gray is improper and the entire rejection should be withdrawn.

Moreover, Gray and Official Notice, whether considered alone or in combination, fail to teach or suggest preventing or allowing debit card access to a third party account using information received from a fund depositor. Gray teaches that students receive a kit containing an ATM

card. The parent has no choice but to allow debit card access. Accordingly, independent claim 75 is patentable over Gray and Official Notice because the combination of Gray and Official Notice fails to teach or suggest each and every limitation of claim 75, particularly the ability of a parent/fund deposition to permit or allow debit card access. Because claims 78-83, 85, 87 and 114 depend from and incorporate all of the limitations of claim 75, claims 78-83, 85, 87 and 114 are also patentable over Gray and Official Notice. Accordingly, Applicant requests that the §103 rejections associated with claims 75, 78-83, 85, 87 and 114 be withdrawn.

All of the stated grounds of rejection have been properly traversed, accommodated or rendered moot. Applicant therefore respectfully requests that the Office reconsider and withdraw all presently outstanding rejections. There being no other rejections, Applicant respectfully requests that the current application be allowed and passed to issue.

If the Office believes for any reason that personal communication will expedite prosecution of this application, I invite the Examiner to telephone me directly.

AUTHORIZATION

No fees other than those listed above are believed to be due for this submission. However, the Commissioner is hereby authorized to charge any additional fees which may be required for this Amendment, or credit any overpayment, to deposit account no. 50-1943.

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Respectfully submitted,
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